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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,648	09/10/2003	Benedict F. Marnocha	35109/82668	3664
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Barnes & Thornburg 600 One Summit Square Fort Wayne, IN 46802				
			EXAMINER PASSANITI, SEBASTIANO	
			ART UNIT 3711	PAPER NUMBER

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SA

Office Action Summary

Application No.

10/659,648

Applicant(s)

MARNOCHA, BENEDICT F.

Examiner

Sebastiano Passaniti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This Office action is responsive to communication received 02/22/2005 –
Response.

Claims 1-20 remain pending.

Following is an action on the MERITS:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 3, 10, 12 and 13 STAND rejected under 35 U.S.C. 103(a) as being unpatentable over Yang in view of Bontomase and Taylor. Yang discloses the invention substantially as claimed, but lacks a non-light-producing insert. In order to maintain the "regulation" status of the club head and to avoid altering the performance of the head, it would have been obvious to replace the light-producing-insert with a non-light-producing insert, since it has been shown to be old in the art to modify a club head putter for practice purposes and to further transform the putter into an arrangement that is intended for regulation play. In this regard, the patent to Bontomase is cited to show that the practice sighting element held within a cavity within the head is "replaced" with a core that in this case is inverted so that there is no depreciable weight shift in the putter head while at the same time making the putter head legal for regulation play. Of further significance is the patent to Taylor, which is cited to show in an analogous fashion that the tip for a cue that has been altered for practice is reverted back to its

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original design. The modification creates no appreciable change in the weight, shape or balance of the cue (col. 2, lines 43-55 in Taylor). Specific to claims 10 and 12, see col. 1, lines 48-58 in Yang. As to claim 13, the skilled artisan would have found it obvious to provide any convenient structure for holding the insert within the club head during use. The use of a snap fit is not deemed to patentably define over the arrangement used in Yang or even Yang as modified by Bontomase.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yang in view of Bontomase, Taylor and McAllister. Yang in view of Bontomase and Taylor has been discussed. To have positioned a transparent material over the aperture (13) in the Yang device merely to protect the laser light or diode or structure behind the face from damage that might have occurred during an impact with a golf ball would have been obvious in view of the patent to McAllister, which shows it to be old in the art to take advantage of a clear impact cover plate (25) to protect the underlying weight elements. Further, such a modification would have further involved nothing more than common sense.

Claims 5-9, 14, 15, 17, 18, 19 and 20 STAND rejected under 35 U.S.C. 103(a) as being unpatentable over Yang in view of Bontomase, Taylor, Cloud and Stock. Yang in view of Bontomase and Taylor has been discussed. To have further modified the device in the cited art reference to Yang by including a prism and a target that reflects the laser beam initiated from the putter head so that a golfer may have a distinct line of sight (i.e., path of light to follow) between the putting face and the intended target would have been obvious in view of the patent to Stock, which shows it to be old in the art to

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provide a laser apparatus with a prism for to target the highly directional beam of light from the putter face to the target. See col. 5, line 28 through col. 6, line 14 in Stock. Further, the use of a target to reflect the laser beam, as required by claims 7, 9 and 14 and more specifically the use of a target with markings as required by claim 15 would have been obviated by the Cloud teaching. See Figure 6 and col. 3, lines 48-65 in Cloud.

Claim 11 STANDS rejected under 35 U.S.C. 103(a) as being unpatentable over Yang in view of Bontomase, Taylor and Vargo. Yang in view of Bontomase and Taylor has been discussed above. To have further modified the device in the cited art reference to Yang by locating the aperture associated with the light-producing-insert closer to the midpoint of the ball-striking face in order to help a golfer focus on lining up the center or sweet spot of the club head with an intended target would have been obvious in view of the patent to Vargo, which shows it to be old in the art to include a laser light insert situated adjacent the center of the striking face in order to improve a golfer's putting ability. See Figure 1 in Vargo, which discloses that the light will be emitted through the front face proximate the center of the ball-striking face.

Claim 16 STANDS rejected under 35 U.S.C. 103(a) as being unpatentable over Yang in view of Bontomase, Taylor, Cloud, Stock and Gross. To have further modified the Yang device by including a target that is accommodated within a golfing hole so that the golfer's sight is focused on the end target and not perhaps on an intermediate location somewhere ahead of the golfing hole would have been obvious in view of the patent to Gross, which shows it to be old in the art to include a reflective target (64)

mounted to a flagstaff that is to be mounted within a golfing hole. The arrangement provides a light source to focus a light path from the striking face to the reflective target. See Figure 5A in Gross.

RESPONSE TO ARGUMENTS

In the arguments received 02/22/2005, the applicant contends that the prior art references have been combined using impermissible hindsight and that the prior art references are not related to one another, thus allegedly strengthening the applicant's position that the prior art devices have been improperly combined. The complete text of applicant's arguments will not be repeated here, for brevity. However, a short summary of applicant's remarks will be set forth in combination with a response to each argument, below.

In response to these arguments, in general, it is noted that one cannot show non-obviousness by attacking references individually where, as here, the rejection is based on a combination of references. See In re Keller, 208 USPQ 871 (CCPA 1981). Note, the test for combining references is not what the individual references themselves suggest. Rather, it is what the combination of prior art disclosures taken as a whole would have suggested to one having ordinary skill in the art. See In re McLaughlin, 170 USPQ 209 (CCPA 1971).

With respect to the applicant's arguments and the rejection of claims 1, 2, 3, 10, 12 and 13 under 35 U.S.C. 103(a) as being unpatentable over Yang in view of Bontomase and Taylor, the applicant asserts that the teaching references cannot be incorporated into the primary reference as outlined in the rejection. The Courts have

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long settled that the test for obviousness is not whether the features of one reference can be bodily incorporated into the structure of another and proper inquiry should not be limited to the specific structure shown by the references, but should instead be into the concepts fairly contained therein, and the overriding question to be determined is whether those concepts would have been suggested to one of ordinary skill in the art the modifications called for by the claims. See In re Van Beckum, 169 USPQ 47 (CCPA 1971). Here, both Bontomase and Taylor distinctly recognize a practice scenario as well as an actual playing environment, whereby the striking implement is modified during the practice scenario and subsequently returned to an unmodified state in an actual playing environment in which neither the weight nor overall shape of the striking element is altered. Thus, the teachings of Bontomase and Taylor would have collectively and reasonably suggested to the skilled artisan that it would have been obvious to modify the Yang device to include a non-practice arrangement for the light producing insert.

With respect to the applicant's arguments and the rejection of claims 4-9, 14, 15, 17, 18, 19 and 20 under 35 U.S.C. 103(a) as being unpatentable over Yang in view of Bontomase, Taylor, Cloud and Stock, the applicant asserts that Stock does not disclose a manner in which to columnate beam 38 on a surface through the use of a prism and that Cloud fails to contribute to the combination in any way. Here, it is noted that the rejection clearly sets forth that Stock references a prism arrangement to target the highly directional beam of light from the putter face to the target. See col. 5, line 28

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through col. 6, line 14 in Stock. Further, Cloud clearly obviates the use of a target with markings as required by claim 15. See Figure 6 and col. 3, lines 48-65 in Cloud.

Specific to claim 4, applicant's attention is directed to the rejection newly set forth under 35 U.S.C. 103(a) as being unpatentable over Yang in view of Bontomase, Taylor and McAllister, supra. The McAllister reference has been applied directly in response to applicant's challenge that a reference be cited to show the common sense aspect of providing a transparent material over an aperture. Reference is made to MPEP

§2144.03 (D) stating:

If the examiner adds a reference in the next Office action after applicant's rebuttal, and the newly added reference is added only as directly corresponding evidence to support the prior common knowledge finding, and it does not result in a new issue or constitute a new ground of rejection, the Office action may be made final. If no amendments are made to the claims, the examiner must not rely on any other teachings in the reference if the rejection is made final. If the newly cited reference is added for reasons other than to support the prior common knowledge statement and a new ground of rejection is introduced by the examiner that is not necessitated by applicant's amendment of the claims, the rejection may not be made final. See MPEP§ 706.07(a).

With respect to the applicant's arguments and the rejection of claim 11 under 35 U.S.C. 103(a) as being unpatentable over Yang in view of Bontomase, Taylor and Vargo, the applicant asserts that the prior art to Vargo does not cure the deficiencies present in Yang. Here, Vargo is cited to clearly set forth the commonness of providing an aperture located at an approximate midpoint of the ball-striking surface. As both Yang and Vargo are concerned with the use of a laser-style light to assist a golfer in aiming the putter, it is clear that these two references are clearly and properly combinable.

With respect to the applicant's arguments and the rejection of claim 16 under 35 U.S.C. 103(a) as being unpatentable over Yang in view of Bontomase, Taylor, Cloud, Stock and Gross, the applicant asserts that unlike the present invention the target in the cited art reference to Gross is positioned within the target cup and would not allow regulation-like play. Applicant's arguments are without merit. The instant specification states that "[t]arget 22 is shown inserted into a hole 34 which may be a hole on a practice green or a regulation green, or another object in an indoor or outdoor setting. This invention allows the user to become accustomed to and practiced [sic] at aiming the ball striking surface 16 of the club 10 directly at target 22" [SPECIFICATION, PAGE 8, LINES 3-6]. It is not seen how this disclosed arrangement allows a golfer to practice under regulation-like conditions and argued on page 8 of the 02/22/2005 remarks. It is not understood exactly what distinction the applicant is trying to make between the patent to Gross applied in the rejection and the limitations in claim 16. Gross shows it to be old in the art to include a reflective target (64) mounted to a flagstaff that is to be mounted within a golfing hole. The arrangement provides a light source to focus a light path from the striking face to the reflective target. See Figure 5A in Gross. This is what is required by claim 16.

With respect to the applicant's arguments and the rejection of claim 1 as being unpatentable over Vargo in view of Au, the applicant asserts that the combination of Vargo and Au fails to produce a non-light producing insert and would at most produce a putter having a laser along with the ability to manipulate the swing weight and sweet spot of the putter head. These arguments on page 8, last full paragraph of the

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02/22/2005 remarks are deemed persuasive and thus the rejection of claim 1 based upon Vargo and Au has been withdrawn.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sebastiano Passaniti
Primary Examiner
Art Unit 3711

S.Passaniti/sp
May 13, 2005